

REMARKS

Claim Amendments

Claim 36 has been amended to correct a typographical error (by removing obviously redundant language, *see* the "an elastically deformable zone between the saddle-shaped receivers" clause) without narrowing the scope thereof. This amendment does not introduce new matter.

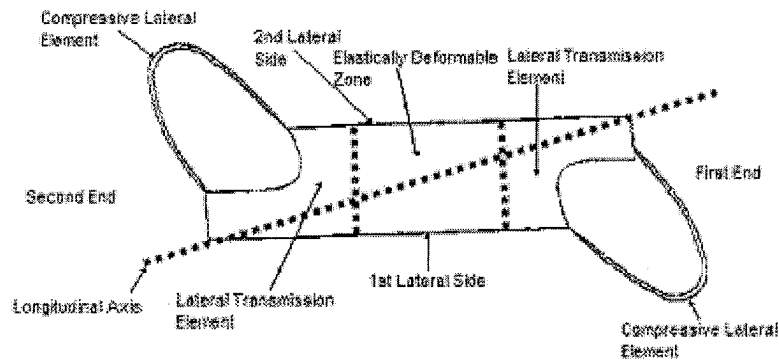
Allowable Claim 35

Applicant notes with appreciation that dependent claim 35 is indicated as allowable. However, because Applicant believes that the corresponding independent claim defines patentable subject matter, Applicant is not amending claim 35 to be in independent form at this time.

§ 102 Rejections over Zucherman

Claims 14-21, 26-28, 33, 36-37 stand rejected under §102 as being anticipated by U.S. Patent Publication No. 2001/0016743 (Zucherman).

Independent claim 14 requires, *inter alia*, a wedge that includes "first and second opposing ends" that are "each shaped to engage with and to receive the respective spinous processes." In addition, claim 1 requires "lateral transmission elements disposed between the compressive lateral elements and the wedge" that are "configured to selectively press against the lateral sides of the wedge ... in the transverse direction." In the rejection, the Action includes the following illustrated interpretation of Zucherman on page 4 of the Action:



Even assuming *arguendo* that the left/right ends of Zucherman are considered as the claimed lateral transmission elements, the Zucherman device still cannot anticipate because these putative lateral transmission elements do not "press against the lateral sides of the wedge," as claimed. From the illustration above, it is readily apparent that the labeled lateral transmission elements may arguably press against the labeled "elastically deformable zone," but they cannot *press against* the labeled lateral sides. In order press against the labeled lateral sides, the relevant force would have to be applied in a generally vertical direction (in the illustrated orientation). But, the labeled lateral transmission elements are disposed to the horizontally left and right, not vertically above/below. Thus, the parts of the Zucherman device labeled as "lateral transmission elements" are incapable of "press[ing] against the lateral sides of the wedge... in the transverse direction," as claimed. Accordingly, Zucherman cannot anticipate independent claim 14 or its dependent claims.

Likewise, independent claim 28 requires, *inter alia*, a wedge with "first and second opposing ends, each shaped to engage with and to receive the respective spinous processes." In addition this claim requires "first and second lateral transmission elements disposed respectively between the first compressive lateral element and the wedge and the second compressive lateral element and the wedge." These lateral transmission elements are required to be "adapted to press against the lateral sides of the wedge... in the transverse direction."

Applicant submits that independent claim 28, and its dependent claims, are not anticipated by Zucherman for substantially similar reasons as discussed above with respect to independent claim 14.

Independent claim 36 requires, *inter alia*, "first and second longitudinally extending compressive lateral elements disposed adjacent to and spaced apart from the lateral sides of the interspinous wedge." With reference to the to the illustration above, the parts labeled as the compressive lateral element appear to be touching the lateral sides of the Zucherman "wedge," and are not "spaced apart" therefrom as claimed. Further, it is unclear to Applicant how the parts labeled as compressive lateral elements in Zucherman can be considered to be "longitudinally extending," as required by the claims, because they appear to be extending almost directly perpendicular to the labeled "longitudinal axis." The Examiner is requested to clarify this point if the rejection is maintained.

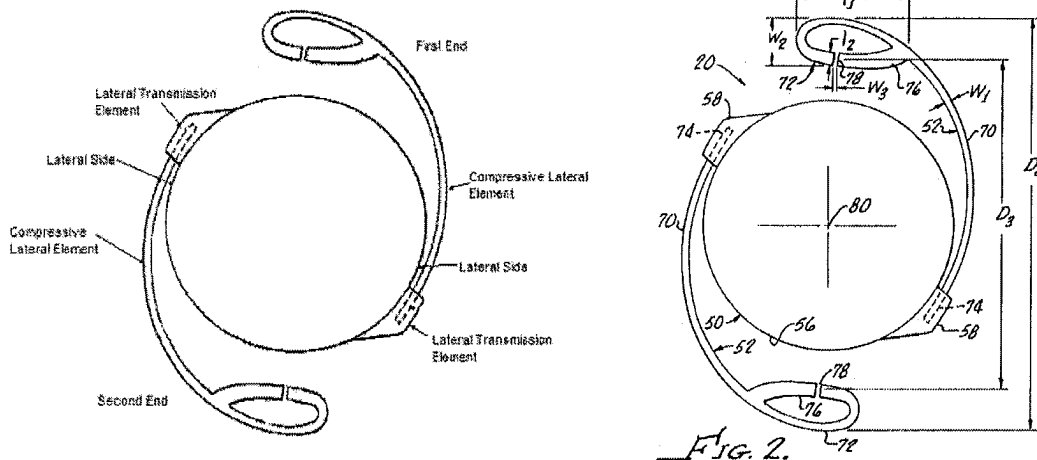
Further, claim 36 requires "lateral transmission elements" that are "configured to selectively increase and decrease loading against the lateral sides of the wedge in the transverse direction." As discussed above with respect to independent claim 14, the putative lateral transmission elements in Zucherman appear incapable of modifying the loading "against the lateral sides of the wedge," quite simply because they are not disposed so as to face or engage the wedge's lateral sides.

In view of the above, Applicant submits that independent claim 36, and its dependent claim 37, are not anticipated by Zucherman.

§ 102 Rejections over Portney

Claims 14-21, and 26-27 stand rejected under §102 as being anticipated by U.S. Patent No. 6,152,959 (Portney).

Independent claim 14 requires, *inter alia*, "two lateral transmission elements disposed between the compressive lateral elements and the wedge, and configured to selectively press against the lateral sides of the wedge." The Action asserts that 1) the "optic 50" of Portney is the claimed wedge; 2) the "fixation elements or haptics 52" of Portney are the claimed compressive lateral elements; and 3) the bosses 58 are the claimed lateral transmission elements. See the illustration from page 6 of the Action and Fig. 2 of Portney, both reproduced below:

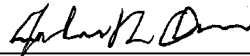


Even assuming *arguendo* that the optic can satisfy all the limitations of the wedge, Applicant respectfully submits that the Portney bosses do not "press against" the lateral sides of the wedge as claimed. The Portney bosses 58 are mounted to the edge 56 of the optic 50. There is no apparent way for the bosses to internally generate a pressing force, so any pressing force that can conceivably be transmitted by the bosses must be externally generated. The only possible candidates for generating a radially inwardly directed force are the haptics, since they are the only other element connected to the bosses. Portney plainly describes the haptics as being flexible (col. 4, line 66 to col. 5, line 17) and that the haptics are oriented tangential to the putative wedge at the bosses 58 (col. 5, lines 3-6 ("A proximal end 74 of each haptic 52 is fixed

into an associated one of bosses 58 (FIG. 2) so that haptic proximal end region 70 extends in a direction *tangential* to optic edge 56."). A flexible cord/strap mounted tangentially to a peripheral edge of a round object can apply a rotational force (shear or torque) to the object, but simply cannot "press against" the object of its own accord. Thus, the Portney haptics 52 are incapable of supplying an inwardly directed force to the bosses. And, without such, the bosses simply cannot "press against" the optic 50, as claimed. Therefore, Applicant submits that Portney does not anticipate independent claim 14 because the putative bosses do not and cannot "press against ... the wedge" as claimed.¹ As such, Applicant submits that independent claim 14 and its dependent claims define patentable subject matter over Portney.

In view of the above amendments and remarks, the Applicant submits that the present application is in condition for allowance and such action is respectfully requested.

Respectfully submitted,
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Dated: July 24, 2008

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¹ Applicant also continues to maintain that the Portney device does not satisfy the limitations of an interspinous wedge configured to be inserted between the spinous processes of two vertebrae" with "first and second opposing ends, each shaped to engage with and to receive the respective spinous processes" for the reasons earlier submitted.